

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Specialty Coffee Association of America, Inc.

v.

CSC-Italia Associazione Caffè Speciali Certificati

Opposition No. 91156520
to Application Serial No. 76333785

Stuart J. Adelson of Law Offices of Stuart J. Adelson for
Specialty Coffee Association of America, Inc.

Cecilia M. Perry of McGlew and Tuttle, P.C. for CSC-Italia
Associazione Caffè Speciali Certificati.

Before Quinn, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

CSC-Italia Associazione Caffè Speciali Certificati seeks
registration on the Principal Register of the term CERTIFIED
SPECIALITY COFFEE for goods identified in the application, as
filed, as "high quality and estate coffee" in International
Class 30.¹

¹ Application Serial No. 76333785 was filed on November 5, 2001
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce. Applicant has disclaimed the words
"Certified" and "Coffee" apart from the mark as shown.

Registration has been opposed by the Specialty Coffee Association of America, Inc., on the grounds that it is a trade association for specialty or high quality coffee; that the terms "specialty coffee" and "speciality coffee" are merely descriptive and generic when used in connection with applicant's goods; that the addition of the word "certified" does not change the merely descriptive or generic nature of these terms, and that the involved term should be found unregistrable under Section 2(e)(1) of the Trademark Act; and that opposer is likely to be damaged by the registration of applicant's proposed term inasmuch as it would impair opposer's ability to use the merely descriptive or generic phrase "certified specialty coffee" to describe marketing by its international members of a grade of coffee beans having no primary defects and some distinguishing characteristics in the flavor of the coffee, as well as use in connection with a variety of associated products, as part of a future certification of specialty/speciality coffee and related products.

In its answer, applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; the trial testimony, with related exhibits, of Ted Raymond Lingle, opposer's executive director;

a notice of reliance upon dictionary definitions filed by opposer on March 29, 2004; and a notice of reliance upon dictionary definitions, opposer's responses to interrogatories and opposer's response to the request for documents, filed by applicant on May 20, 2004. Opposer and applicant have fully briefed the case.

Turning first to the question of standing, we find that, opposer has sufficiently pleaded and proven that it is not a mere intermeddler, but rather has a real interest in the outcome of this proceeding and a reasonable basis for its belief of damage. See Section 13 of the Act (15 U.S.C. §1063). See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). Accordingly, we find that opposer has standing to maintain this opposition proceeding.

We turn then to the question of whether the term CERTIFIED SPECIALITY COFFEE is merely descriptive of "high quality and estate coffee."

Opposer contends that the word COFFEE is generic for applicant's goods, and applicant has disclaimed this term. Opposer shows from dictionary definitions that CERTIFIED means "to guarantee as meeting a standard," and is descriptive of the fact that "applicant's coffee meets a standard." Opposer's brief, p. 7. Again, applicant has disclaimed this

term, seemingly acknowledging the descriptive nature of this term. While we must look at the term in its entirety in order to determine whether the composite is descriptive, much of the disagreement between opposer and applicant centers on the second word in this three-word term, SPECIALITY.

In this context, opposer contends that applicant's composite "merely describes the exact nature of the Applicant's goods and services, namely, speciality coffees which meet a certain standard." Opposer's brief, p. 7. At the core of opposer's argument is the contention that the evidence of record shows that the words "specialty" and "speciality" have "similar meaning, intent and understanding, and that the spelling of Speciality with an added 'i' is basically a British and European variance in style rather than in meaning or substance." Opposer's brief, p. 9.

Opposer's executive director, Ted R. Lingle, offered by opposer as an expert in the coffee industry, details how the term "specialty coffee" has become a term of art in the United States within the coffee industry over the past thirty years as a shorthand designation for high quality coffee beans and the beverage derived therefrom. Trial testimony of Ted R. Lingle, pp. 15, 17. It is opposer's position that there is no difference between the terms "specialty coffee" and "speciality coffee" - that "specialty" is the preferred

spelling in the United States while "speciality" is the preferred spelling in England and other countries in Europe where the English language is used. Trial testimony of Ted R. Lingle, p. 17, testimony exhibits 3 - 5.

In support of its position that this composite term is suggestive, applicant argues that "specialty" and "speciality" are quite different - not equivalent words - when used with coffee, and that opposer has not met its burden of showing descriptiveness under any of the established tests that have been used to determine descriptiveness.

A term is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely

descriptive is to consider the term in relation to the goods and services for which registration is sought, the context in which the term is used or is intended to be used, and the possible significance that the term is likely to have on the average purchaser encountering the goods and services in the marketplace. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Applicant argues in its brief that none of the four established tests that shed light on the line between suggestiveness and descriptiveness, when applied to the facts of this case, supports the conclusion of mere descriptiveness as alleged by opposer.² Following this structure, we look at

² See, e.g., McCarthy on Trademarks and Unfair Competition by J. Thomas McCarthy, §11:66 "Tests for determining descriptive-suggestive distinction," footnote 1:

"See Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983) (in a clear and well-articulated evaluation of the descriptive-suggestive distinction, the Fifth Circuit expressly applied four tests: (1) dictionary definition; (2) imagination test; (3) competitors' need test; and (4) competitors' use test); No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985) (the Trademark Board adopts the three part test used in this treatise: degree of imagination; competitors' use; and competitors' need)"

whether the evidence of record supports suggestiveness or mere descriptiveness when applied to each of these approaches.

(i) The dictionary definition test

In support of its position that this phrase is suggestive, applicant argues correctly that there is no dictionary entry for the three-word phrase, CERTIFIED SPECIALITY COFFEE, and that this fact should weigh in applicant's favor. On the other hand, whether or not a term is found in the dictionary is not controlling on the question of registrability provided the composite term has a recognized meaning. In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977) [BREADSPRED is merely descriptive of function or use of jams and jellies even if it is not a dictionary term]. We note that very rarely would a three-word phrase appear in any dictionary as a single entry. However, opposer may rely upon dictionary definitions of individual elements in a multi-word phrase. If each component retains its descriptive significance in relation to the goods, the term as a whole results in a composite that is itself descriptive. See In re Putman Publishing Co., 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry]; In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE

merely descriptive of "facsimile terminals employing electrophoretic displays"]; In re Serv-A-Portion Inc., 1 USPQ2d 1915 (TTAB 1986) [SQUEEZE N SERV held to be merely descriptive of ketchup and thus subject to disclaimer]; In re Uniroyal, Inc., 215 USPQ 716 (TTAB 1982) [STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts].

Moreover, the involved combination does not create an incongruous expression or a double entendre, nor does it create an association with a known phrase. *Contra In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) [SUGAR & SPICE not merely descriptive for bakery products because this "stimulates an association with the nursery rhyme"].

Opposer has placed into the record four dictionary entries for the word "speciality":

speciality, *n*, *Chiefly Brit.* Specialty. ... SEE SPECIALTY³

speciality, *n*, 1. A specific or individual characteristic; peculiarity. 2..Specialty (defs. 3, 4, 5) - In British usage, this form is preferred instead of *specialty* -⁴

speciality, 1. A special, particular, or individual point, matter, or item;... 2. The quality of being special, limited or restricted

³ Random House Compact Unabridged Dictionary, Special Second Edition, pp. 1830 - 1832.

⁴ Funk & Wagnall's Comprehensive Standard International Dictionary, Bicentennial Edition, p. 1204.

in some respect... 3.a. A special or distinctive quality, property, characteristic or feature; a peculiarity; 3.b. With *the*: The distinctive quality, etc., of a particular thing or class... 6.a. A thing or article of a special kind, as distinguished from what is usual or common...⁵

speciality, n, 1. A distinguishing mark or feature. 2. specialities Special points of consideration; particularly. 3. *Chiefly British* A specialty.⁶

As noted by opposer, three of the above four dictionary entries show "speciality" as a synonym (and the British preference) for the word "specialty." Of course, each word appears separately in all these dictionaries, and despite an overlap in meaning, one can also detect between the entries a nuanced difference in meaning.

Applicant has placed in the record multiple entries from other dictionaries where "specialty" does not appear as a synonym for "speciality" (or vice versa). Applicant has also placed into the record an entry from a website posted by EEI Communications that applicant argues explicitly supports its position that these two words do *not* have overlapping meanings:

⁵ The Oxford English Dictionary, Second Edition, Vol. XVI, pp. 152 - 154.

⁶ The American Heritage Dictionary of the English Language, Fourth Edition, p. 1669.

The Right Word

specialty/speciality

Several dictionaries say that both spellings are acceptable and that the words are synonyms, but most editors consider *specialty* to be the correct spelling for American audiences. *Speciality* is the preferred spelling in British English, though copywriters seem attracted to it, perhaps because it sounds like the French *specialité*.

But for those who want more than this simple rule of thumb, *The American Heritage Dictionary*, third edition (*AHD*), gives first meanings to *speciality* -- "a distinguishing mark or feature" -- and the plural *specialities* -- "special points of consideration, particulars" -- that do not overlap with *specialty* at all. The third definition ends up by agreeing that *speciality* is British usage for *specialty*.

Specialty itself is treated quite separately. *AHD* refers us to *forte* (not *speciality*) as a synonym for it in the sense of "a special pursuit, occupation, aptitude, or skill." Other definitions relating to distinctiveness or superiority are offered along with *specialty*'s legal sense of "a special contract or agreement, especially a deed kept under seal."

In short, it's unlikely that *speciality* is the best choice in most contexts outside of Britain, no matter what your spell checker says. Now you know why.

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Of course, this usage note submitted by applicant refers to The American Heritage Dictionary of the English Language entry for "speciality" already placed into the record by opposer.⁸ Moreover, the final sentence above appears to undercut applicant's argument. It seems to confirm that spell checkers and copywriters in the United States use the term "speciality" as a synonym for "specialty." Even in those dictionaries proffered by applicant that do not specifically list the words "specialty" and "speciality" as synonyms for each other, the same themes of "distinctiveness," "special feature" and "peculiarity" occur in each of these very similar

⁷ <http://www.eeicomunications.com/eye/special.html>

⁸ See dictionary entry in the text *supra* at footnote 5.

words. We agree with opposer that based on this record as a whole, the words "specialty" and "speciality," especially when combined with the word "coffee," are interchangeable, with both spellings having the same meaning, intent and understanding.

In any event, when the word "specialty" modifies the word "coffee," there is ample evidence from the dictionary definition alone to support the opposer's contention that the term "specialty coffee" is at the very least descriptive for high quality and estate coffee. Even if applicant's chosen spelling of "speciality" (with the letter "i") were not listed in a single English-language dictionary, it would not mean that the term was not merely descriptive for high quality and estate coffee. It is clear that the slight difference between "specialty" and "speciality" often would not even be noticed. For example, in the initial Office action in the underlying application, the Trademark Examining Attorney assigned to this application did not notice the difference in spelling.⁹ If prospective purchasers even noticed the addition of the letter "i" at all, they would recognize "speciality" as simply a

⁹ Opposer points out that the Trademark Examining Attorney in the instant file told applicant in the initial Office action that this was a *duplicate application* to an application that applicant had earlier filed for CERTIFIED SPECIALTY COFFEE, and that when doing a LEXIS/NEXIS search for a possible finding of mere descriptiveness in this case, she used the American spelling "specialty."

slight misspelling of the term "specialty." The United States Supreme Court has held that:

The word, therefore is descriptive, not indicative of the origin or ownership of the goods; and being of that quality, we cannot admit that it loses such quality and becomes arbitrary by being misspelled. Bad orthography has not yet become so rare or so easily detected as to make a word the arbitrary sign of something else than its conventional meaning...

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 455 (1911).¹⁰

Accordingly, we conclude under "the dictionary definition test," that applicant's term should be found to be merely descriptive of a significant feature of the identified goods.

(ii) The imagination test

Applicant argues that:

The phrase CERTIFIED SPECIALITY COFFEE does not instantly give information about the goods. It is an ambiguous phrase. Imagination is needed to obtain any meaning.

Applicant's appeal brief, p. 23. However, we find this term to be a fairly straightforward combination of words that creates no double entendre, no incongruity, no contradictory

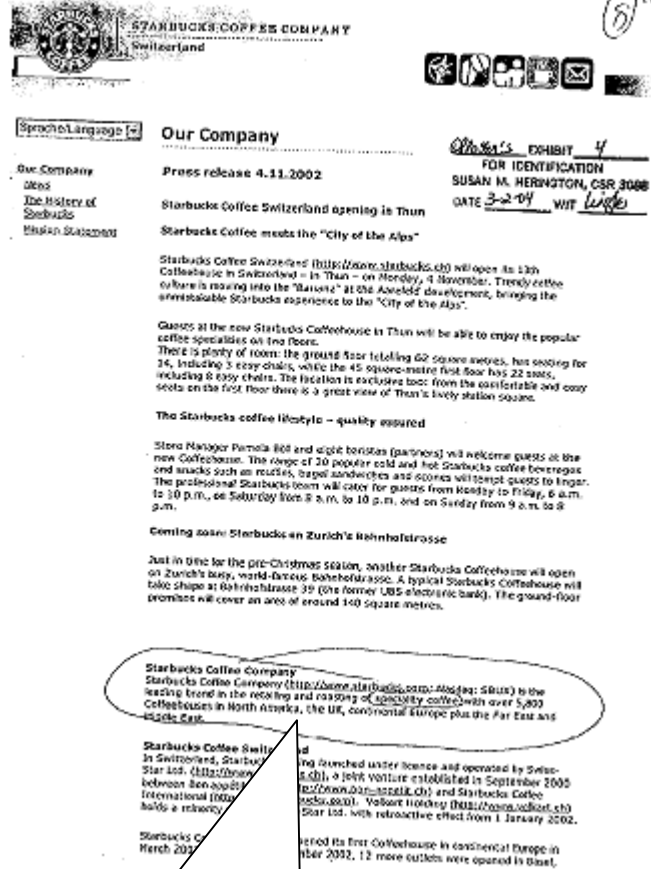
¹⁰ Other cases have recognized that a slight misspelling does not change a merely descriptive term into a suggestive term. Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938) [NU-ENAMEL; NU held equivalent of "new"]; In re Quik-Print Copy Shops, 616 F.2d 523, 205 USPQ 505 (CCPA 1980) [QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'"]; In re Organik Technologies Inc., 41 USPQ2d 1690 (TTAB 1997) [ORGANIK]; and Hi-Shear Corp. v. National Automotive Parts Association, 152 USPQ 341 (TTAB 1966) [HI-TORQUE "is the phonetic equivalent of the words 'HIGH TORQUE'"].

or odd meanings, no play on words, etc. See In re Colonial Stores, Inc., *supra*. Moreover, as indicated above in our discussion of the dictionary definitions of the individual components of CERTIFIED SPECIALITY COFFEE, when one views the common meaning of the words "certified," "speciality" (or "specialty") and "coffee," it takes no amount of mental processing to conclude that this phrase, when viewed in its entirety, "merely describes the Applicant's goods as coffee which is certified as speciality coffee because the coffee is a distinct kind or of particular superiority, namely high quality and estate." Opposer's brief, p. 7.

It is clear from this entire record that in the United States (as well as internationally) there is a distinct segment of the coffee industry marketing a product category known simply as "specialty coffee." Without a doubt, this spelling of the word "specialty" is the predominant spelling of this term in the United States and elsewhere in the Americas.

On the other hand, the record shows that the term "specialty coffee" changes its spelling to "speciality coffee," but not its meanings, as it moves across the Atlantic. This is made starkly clear from opposer's submission of two different websites associated with the Starbucks Corporation. Starbucks, the largest specialty

coffee retailer in the world, uses the term "specialty coffee" on its U.S. website, yet in a similar context on its Swiss website, uses "speciality coffee":¹¹



Starbucks Coffee Company is the leading retailer, roaster and brand of **specialty coffee** in the world, with more than 6,000 retail locations in North America, Latin America, Europe, the Middle East and the Pacific Rim.

Starbucks Coffee Company (<http://www.starbucks.com>; Nasdaq: SBUX) is the leading brand in the retailing and roasting of **speciality coffee**, with over 5,800 Coffeehouses in North America, the U.K., continental Europe plus the Far East and Middle East.

Similarly, the counterpart organization to opposer, which opposer helped to start in Europe, deliberately chose the

¹¹ The relevant paragraphs in both of these webpages were circled by opposer, while the callout boxes and bold letters have been supplied for the ease of readers.

European spelling in naming their organization "The Speciality Coffee Association of Europe."

Opposer also notes that this trans-Atlantic difference in spelling certain words is a rather common phenomenon, citing to the spelling of other words like "color-colour," "program-programme," etc., to which we might add "defense-defence," "organization-organisation," "center-centre," "flavor-flavour," etc.

We agree with opposer that when applicant's applied-for term, CERTIFIED SPECIALITY COFFEE, is used in connection with the identified goods, it immediately conveys information as to the type of coffee that applicant and/or its own members would be offering, namely that applicant's (and/or its members') coffees meet high quality standards.

(iii) Competitors' need test

In order to determine correctly the need of competitors to use the term, it is incumbent upon us to define clearly the field of competition. While this might include coffee growers and vendors, the term "certified" suggests use by trade groups, cooperatives, etc. Opposer is just such a trade group, having thousands of members all over the world making it the largest trade group in the world representing those in

all facets of the high-quality coffee market from growers to office place coffee vendors.

Opposer's membership lists includes well-known companies based in the United States, such as Starbucks, Dunkin' Donuts, Procter & Gamble Co. (Millstone), Kraft General Foods (Gevalia), Sara Lee, etc. The record also shows that opposer has cooperative relationships (groups that it calls "marketing partnerships") with a variety of coffee trade associations around the world, including organizations such as The Speciality Coffee Association of Europe, The Speciality Coffee Association of India, The Specialty Coffee Association of Panama, Brazil Specialty Coffee Association, etc.

It seems reasonable that opposer, the Specialty Coffee Association of America, might well be uniquely positioned to "certify" a variety of items connected with the sale of coffee beans, commercially vended coffee beverages, the equipment for grinding and brewing coffee, etc. In fact, according to testimony in the record, opposer uses other terms having the word CERTIFIED in them. For example, opposer's executive director discussed one of opposer's programs through which it certifies commercial coffee brewing machines. Trial testimony of Ted R. Lingle, pp. 35 - 37.

Mr. Lingle also testified to opposer's plans to actually certify specialty/speciality coffees based upon a detailed set

of criteria established long ago by opposer, a copy of which has been made a part of the record. Trial testimony of Ted R. Lingle, pp. 21, 37 - 39, exhibit 1.

As noted *supra*, the record makes it clear that "specialty coffee" is a highly descriptive, if not generic, term in the United States for applicant's goods. In a variety of contexts over the years, this Board has had occasion to find the word "Certified" within larger composite marks to form terms that are merely descriptive.¹² Accordingly, we find that applicant's competitors, international cooperatives, foreign-based trade associations (opposer's "marketing partners"), etc., will have a need to use the highly-descriptive term, "certified specialty coffee" (or "certified speciality coffee").

(iv) Competitors' use test

Applicant argues that neither opposer nor anyone else has been shown to use these three words together -- "certified speciality coffee" -- using either spelling of the word

¹² See e.g., *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992) [DOUBLE CERTIFIED ORGANIC is merely descriptive for pasta]; *In re Professional Photographers of Ohio, Inc.*, 149 USPQ 857 (TTAB 1966) [CERTIFIED PROFESSIONAL PHOTOGRAPHER is highly descriptive if not incapable of distinguishing a professional photographer certified to by applicant]; and *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985) [CERTIFIED MORTGAGE BANKER is so highly descriptive of service providing certification program for mortgage bankers as to be incapable of identifying source of services].

specialty/speciality. On the other hand, the fact that applicant may be one of the first users of a term does not justify registration if the term is merely descriptive. See In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983). Hence, in light of our findings under the dictionary definition test, the imagination test and the competitive need test, *supra*, the fact that none of applicant's competitors has used this exact formulation does not demonstrate that the designation is not merely descriptive.

Moreover, all the evidence of record demonstrates that "specialty coffee" is a readily recognized term for beverages derived from certain high quality coffee beans. Combined with the evidence opposer has made of record, applicant's own identification of goods shows that both parties are involved with the same type of goods. Both organizations would be expected to be involved in certification programs. The dictionary evidence and our precedent demonstrate that the word CERTIFIED is a term meaning "to guarantee as meeting a standard," and is descriptive of the fact that "applicant's coffee meets a standard." When the terms are combined into the composite term CERTIFIED SPECIALITY COFFEE and used for high quality and estate coffee, consumers will readily understand that CERTIFIED SPECIALITY COFFEE refers to a

grade of defect-free coffee beans having distinguishing characteristics in the flavor of the coffee, as well as collateral products associated therewith, marketed by its members. Accordingly, this is an apt term to describe applicant's goods, and hence, we find that the term is merely descriptive under Section 2(e)(1) of the Lanham Act.

Decision: The opposition is sustained and registration to applicant is hereby refused.